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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,199	12/05/2000	Donald J. Kerfeld	10247US01	7264

7590 01/19/2005

Attention: Eric D. Levinson  
Imation Corp.  
Legal Affairs  
P.O. Box 64898  
St. Paul, MN 55164-0898

EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/730,199

Applicant(s)

KERFELD ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-17 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1,3-17,21-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

2. Claims 1, 3 – 6, 11 – 17, 21 – 28 and 30 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 5,202,880) in view of Lewis et al. (U.S. Patent No. 4,519,065), Davis et al. (WO 00/48172) and Ueda et al. (U.S. Patent No. 5,481,530) for the reasons of record as set forth in Paragraph No.'s 3 – 36 of the Office Action mailed on August 12, 2004.
3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. as modified by Lewis et al., Davis et al. and Ueda et al. as applied above, and further in view of Anderson et al. (U.S. Patent No. 4,304,806) for the reasons of record as set forth in Paragraph No.'s 37 – 41 of the Office Action mailed on August 12, 2004.
4. Claims 8 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. as modified by Lewis et al., Davis et al. and Ueda et al. as applied above, and further in view of Kirino et al. (U.S. Patent No. 5,703,855) for the reasons of record as set forth in Paragraph No.'s 42 - 46 of the Office Action mailed on August 12, 2004.

***Allowable Subject Matter***

5. The following is a statement of reasons for the indication of allowable subject matter: claim 29 is allowable for the reasons of record as set forth in Paragraph No.'s 47 – 49 of the Office Action mailed on August 12, 2004.

***Response to Arguments***

6. **The rejection of claims 1, 3 – 17, 21 – 28, 30 - 32 under 35 U.S.C § 103(a) – Lee et al. in view of various references**

Applicant(s) primarily argue(s) that the Examiner “failed to explain why a person of ordinary skill in the art would have found it necessary to replace Al as the reflective layer” (*pages 3 - 6 of response*). The Examiner respectfully disagrees.

The Examiner notes that Al and Cr are known equivalents as evidenced by the art of record. Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* 85 USPQ 328 (USSC 1950).

Applicants further argue Davis “appears to add nothing beyond the similar teaching of Lee, addressed above” (*page 3 of response*). The Examiner notes that Lewis et al. is directed to primarily an optical disk while Davis et al. teaches that one of ordinary skill in the art would recognize the similarity in many of the layers in “recording media”, including optical, magneto-optical and magnetic.

Additionally, applicants argue that “Lewis and Lee references are totally unrelated” given that Lee is related to magneto-optic media and Lewis is related to embossable media (*page 4 of response*). The Examiner respectfully disagrees.

First, the Examiner notes that applicants’ claims are directed to generic “storage media”, which encompasses magnetic, magneto-optic and optical media. Second, the Examiner notes that one of ordinary skill in the art, as supported by the art of record, especially Davis et al., would be well versed in the comparative structure of the various types of media. Since the vast majority of layers in a “recording media” perform the substantially identical functions regardless of the recording layer used, the Examiner deems that one of ordinary skill attempting to improve one area of storage media would be motivated to look in the related fields to discover improvements that would apply equally to all storage media applications. As rudimentary examples, the Examiner notes that all storage media benefit from improved substrates, protective layers and lubricant layers, among other aspects.

Finally, applicants argue that regarding claim 11, “Lee shows grooves, not protrusions” and that “[s]urface variations that form grooves are clearly not protrusions” (*page 5 of response*). The Examiner respectfully disagrees.

The Examiner notes that for every groove, there must be a corresponding “land” or “peak”. These “lands” or “peaks” are protruding above the surface level in the grooves, and hence read on the language of “protrusions”. See Figure I below.

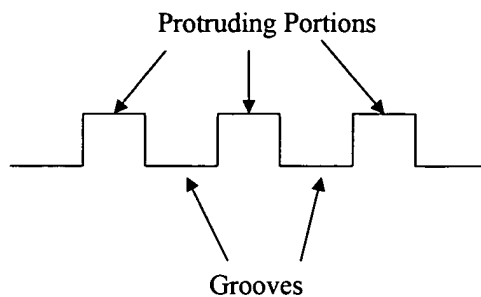


Figure 1: Illustration of "grooves" and corresponding "protrusions"

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

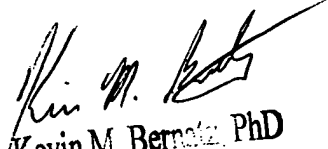
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
January 17, 2005

  
Kevin M. Bernatz, PhD  
Primary Examiner